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REMARKS

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1, 4-5, 7, 11 and 13-15 are pending in the subject application.

Claim 12 was withdrawn from consideration as the result of an Examiner's earlier restriction requirement. In view of the Examiner's restriction requirement, Applicant reserves the right to present the above-identified withdrawn claims in a divisional application.

Claims 1, 4-5, 7, 11 and 13-15 stand rejected under 35 U.S.C. §103. Claims 1, 13 and 14 were objected to because of identified informalities.

Claims 1, 13 and 14 were amended to address the Examiner's objections.

The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §103 REJECTIONS

Claims 1, 4-5, 7, 11 and 13-15 stand rejected under 35 U.S.C. §103 as being unpatentable over Jones in view of Softly both already of record. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, as the amendments only were made to overcome objections to informalities none of the amended features are considered to be specifically relied upon to distinguish the claimed invention from the cited prior art.

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It appears from a reading of the grounds for rejection and the remarks regarding Applicant's prior arguments, that Applicant's arguments are being ignored because of the decisions in, and holdings, of *In re Keller*, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 231 USPQ 375 (CAFC 1986). As discussed further below, the holding of *In re Keller* are in appropriately applied in the present case and the holdings in the *In re Merck* decision make this clear.

The Court in *In re Keller* noted that the sole issue regarding the prior art rejection is essentially whether the references taken collectively, would have suggested the use of digital timing in a cardiac pacer to those of ordinary skill in the art at the time the invention was made.¹ As the Court further noted

To justify combining reference teachings in support of a rejection it is not necessary that a device shown in one reference can be physically inserted into the device shown in the other. (Citations omitted). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. (Citations omitted).

As to the references being cited in the grounds for the rejection, the Court in *In re Keller* provided the following.

Both Keller and Berkovits disclose heart stimulators that use R-C type timing circuits. Walsh teaches the use of digital type timing circuits in place of R-C type timing circuits in conventional heart stimulators. Therefore, the question is whether it would have been

¹ 208 USPQ 871, 880.

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obvious to one of ordinary skill in the art, working with the Keller and Berkovits and the Walsh references before him, to do what the inventors herein have done, that is, to use a digital timing circuit in a cardiac pacer. (Citations omitted). We agree that the references establish a prima facie case of obviousness.²

In reaching a similar conclusion, the Court in *In re Merck* noted that the expectation that compounds having similar structures would behave similarly was suggested in a Report. It also noted that the combination with those teachings, the prior art teaching that the precise structural difference between amitriptyline and imipramine involves a known bioisosteric replacement provides sufficient basis *for the required expectation of success, without resort to hindsight* (emphasis added). Although the Court indicated that obviousness does not require absolute predictability, a reasonable expectation that the beneficial result will be achieved is necessary to show obviousness. (Citations omitted).³

In sum, it is clear from these two decisions that to avoid hindsight reconstruction one must show that the prior art clearly disclose a reasonable expectation of success or that there is a reasonable expectation that the beneficial result will be achieved.⁴ Applicant respectfully submits that one could not conclude that based on the disclosures of the Jones and Softly references that one skilled in the art would have been reasonably apprised that re-configured that concentric vanes taught in Jones with vanes that are at angle with respect to a normal to the

² 208 USPQ 871, 881-882.

³ 231 USPQ 375, 379.

⁴ As provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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surface of the optical lens assembly, would have allowed on looking through the plurality of vanes to be capable of observing while at the same time preventing light coming in from any angle from being reflected from the surface.

As indicated by Applicants in the Preliminary Amendment, claim 1 had been amended so as to clearly indicate that the user of the assembly is viewing the images to be viewed through the apparatus and that the reflections from the surface of the lens assembly (i.e., lens surface) are not viewable by an observer that is distal from the second ends of the apparatus of the presently claimed invention. As has been previously indicated by Applicant such an apparatus is not disclosed or taught by the cited references as the secondary reference only teaches an arrangement whereby the surface of a television monitor can remain visible to an observer that is a distance from the monitor surface and also so the images being observed are not interfered with by reflections from the monitor surface due to overhead lighting. This hardly qualifies as an adequate teaching for dealing with reflections off a surface of wide field of view optical lens assemblies while maintaining the field of view.

As also previously indicated by Applicant, as described in Softly, the slats 21 comprising the light masking device are configured and arranged so that the horizontally extending slats are viewed edge on by the camera 32 and so they do not interfere with the normal viewing by the camera 32 of the image being displayed on the screen of the monitor except to the extent of the slat's thickness which it is provided is minimal (*e.g.*, see col. 2, lines 57-61). It also is described in Softly that the horizontally slats are configured and arranged so as to be suitably positioned to intercept light that otherwise might be reflected from the screen and thus impair the image being

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displayed on the screen. It is further provided that the slats are constrained so as to converge on a horizontal line at a selected height and a selected distance from the screen of the monitor.

Moreover, Softly further describes that the light masking device intercepts the light from an upward direction because most of the light falls towards the monitor screen from the upward direction rather than the side.

In sum, Softly teaches that slats, which are arranged to only extend horizontally and arranged so as to have a specific arrangement with respect to the camera, can prevent reflections from the surface of the television monitor. Nowhere is it taught nor suggested in Softly that a three dimensional array of such slats, such as in the form of concentric circles that extend lengthwise would have the same affect. Moreover, there is no teaching or suggestion that if an observer was on the television side of such a slat assembly that the observer could see through such a slat assembly. To the contrary, an arrangement of concentric vanes as taught by Applicant forms a structure where a vane could occlude a part of the scene being observed in contrast to a vane that is not at an angle with respect to normal from the lens surface. Thus, one skilled in the art would be more likely to conclude that such an arrangement would create an apparatus where the observer would not be able to see.

Applicant also would note that there would have been no express desire to combine either reference as neither reference discloses the problem being resolved by the present invention.

Applicant thus respectfully submits that the cited art does not provide a basis that one skilled in the art would have appraised of a reasonable expectation of success by the combination of the teachings of the two references. Thus, and absent the teachings of the subject application

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there is no basis upon which to combine the teachings of the two references. As such, Applicants submits that contrary to the holding in *In re Merck*, the combination comprises is a hindsight reconstruction of the cited art in view of Applicant's teachings.

As the Federal Circuit has recently stated in *In re SANG-SU LEE*, 271 F.3d 1338, 1342-1344; 277 USPQ 2d 1430 (Fed. Cir. 2002):

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding' ") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988) (" 'teachings of references can be combined *only* if there is some suggestion or incentive to do so.' ") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir.1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir.2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the

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claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

It is respectfully submitted that for the foregoing reasons, claims 1, 4-5, 7, 11 and 13-15 are patentable over the cited reference(s) and thus, satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believes that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105.

Respectfully submitted,
Edwards & Angell, LLP

Date: February 14, 2005

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